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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/581,172	10/04/2000	Helmut Schreiner	1438-30	7232

7590 05/26/2004
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EXAMINER

TREMBLAY, MARK STEPHEN

ART UNIT	PAPER NUMBER
2876	

DATE MAILED: 05/26/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/581,172

Applicant(s)

SCHREINER, HELMUT

Examiner

Mark Tremblay

Art Unit

2876

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attached.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1-14 and 20-37.

Claim(s) withdrawn from consideration: _____.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____.

Applicant has requested the withdrawal of the finality of the previous office action and the entry of the amendment based on the alleged entry by the examiner of a new grounds of rejection in the final office action that was neither necessitated by the Applicant's amendment nor based on an IDS submitted by Applicant. Examiner declines to withdraw the finality of the previous office action.

Examiner assumes that the Applicant's representative is highly experienced in patent prosecution because of the representative's patent bar registration number (32,815), and the cogent responses to Examiner's office actions. Because of this, the representative's claim that the grounds of rejection of claim 37 in the final office action was "new" is unpersuasive.

In the first office action, claims 3 and 20, among others, were rejected over Tiffany in view of Saliga and Dlugos. The substance of claim 3, by itself, was the same as claim 37. Claim 3 was dependent on claim 2, which in turn was dependent on claim 1. Claim 37 was dependent on claim 20, in turn dependent on claim 1.

In the final office action, claims 3, 20, and 37, among others, were rejected over Tiffany in view of Saliga and Dlugos. No new explanation of how these references applied to claim 37 was genuinely required, because of claim 3. The Examiner had provided ample explanation and information to sustain a rejection of claim 37 in the first office action, although that claim number was left out in a typographical error.

Applicant had all the information needed for any experienced patent prosecutor to form an opinion of the patentability of claim 37. If there was any doubt, Applicant could have contacted the examiner for a clarification on claim 37. It should have been

clear to any reasonable patent prosecutor that the omission of claim 37 from the first office action was an oversight or typographical error, because standard practice at USPTO is to address all pending claims. It should have been equally clear to any reasonable patent prosecutor what the examiner's opinion of the patentability of claim 37 was by assuming the omission of claim 37 was an oversight or typographical error, and reading the rejection of claims 3 and 20. Therefore, the Applicant's request for withdrawal of the finality of the previous office action is declined.

With respect to Applicant's request at page 7 "that this paper also be treated as a Petition under 37 C.F.R. 1.181 requesting withdrawal of the Finality..." Applicant's request does not constitute a proper petition. Such a petition must be filed as a separate paper as required under 37 C.F.R. 1.4(c).

With respect to the amendment, it will not be entered because the numerous amendments to the claims require further consideration and possibly search.

Voice

Inquiries for the Examiner should be directed to Mark Tremblay at (571) 272-2408. The Examiner's regular office hours are 10:30 am to 7:00 pm EST Monday to Friday. Voice mail is available. If Applicant has trouble contacting the Examiner, the Supervisory Patent Examiner, Michael Lee, can be reached on (571) 272-2398. Technical questions and comments concerning PTO procedures may be directed to the Patent Assistance Center hotline at 1-800-786-9199 or (703) 308-4357.


MARK TREMBLAY
PRIMARY EXAMINER